

III. REMARKS

Claims 1-9 are pending in this application. Applicant does not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Furthermore, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is requested.

In the Office Action, claims 4-6 and 8 are objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. While Applicant gratefully acknowledges the indication of allowable subject matter, Applicant contends that based on the remarks herein (below) that independent claim 1 is in condition for allowance. As such, any modifications to dependent claims 4-6 and 8 are unnecessary. Accordingly, Applicant requests withdrawal of the objection.

In the Office Action, claims 1 and 9 are rejected under 103(a) as allegedly being unpatentable over Rademacher (U.S. Pat. No. 6,570,918), hereinafter "Rademacher" in view of El-Tahuni et al. (US 6,201,828), hereinafter "El-Tahuni", further in view of Choi et al. (U.S. Pat. App. Publ. No. 2002/0214926), hereinafter "Choi". Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rademacher in view of El-Tarhuni, further in view of Choi and further in view of Aue (US Pat. App. Publ. No. 2002/0051486), hereinafter "Aue". Claim 9 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rademacher in view of El-Tarhuni, further in view of Choi, further in view of Aue and further in view of Bultan et al (US Pat. App. Publ. No. 2004/0057506), hereinafter "Bultan".

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Applicant respectfully submits that all claims are allowable over the cited art. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 706.02(j).

Applicant traverses the rejections for the following reasons.

With regard to claims 1-3, 7 and 9, Applicant respectfully submits that there is no motivation to make the combination of Rademacher, El-Tarhuni, and Choi. In particular, there is no suggestion or motivation in any of the references that would indicate why it would be obvious for one of ordinary skill in the art to combine the interpolation filter 207, of Choi, that "performs up-sampling of the equalized signal to an intermediate frequency signal having sampling frequency for a primary IF modulation and removes harmonic component" (§0087) into the receiver for recovering data from spread spectrum radio signals of Rademacher. Assuming *arguendo* that the Office's assertion that Choi teaches using "a PN code generator filtered by an interpolation filter to remove harmonic components", there is no support in the prior art indicating that it would be obvious to combine this feature into the Rademacher receiver. Specifically, none of the prior art references teach "correlating the delayed signal with the filtered pilot code" (emphasis added), as in claim 1. El-Tarhuni teaches using correlation to determine delay with a low cost and complexity. See e.g., col. 2, lines 36-39. In fact, El-Tarhuni throughout the "Background of the Invention" section repeatedly states that an object of El-Tarhuni is for low (or little) complexity and cost. Contrastingly, Choi discloses a complex

interpolation filter (207) that is discussed at length in Choi from ¶0087 through ¶0099. Given the complexity of the filter in Choi, there would be no motivation to combine El-Tarhuni with Chiod, since El-Tarhuni demands low complexity. This is a clear teaching away from making the averred combination of Choi with El-Tarhuni, as the Office has done so in the Official Action.

“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” (emphasis added) *Karsten Mfg. Corp. V. Cleveland Golf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001). Respectfully, it appears that the Office in making its averred combination, which arguably may be a technical summation, or list, of the various discrete elements of the present invention, has done so via an improper hindsight analysis without showing the requisite motivations for making these numerous combinations so as to amount to the claimed invention, as a whole. Accordingly, Applicants submit that the Office has not met its burden in establishing a *prima facie* case of obviousness with regards to claims 1-3, 7 and 9. Applicants respectfully request withdrawal of the rejection.

Further, with regard to claims 2 and 3, Applicant respectfully submits that there is no motivation to make the further combination of Aue (i.e., incorporation of a multiplier) into the aforementioned Rademacher, El-Tarhuni, Choi combination. Similar to the above discussion regarding Choi, it appears the Office has made the combination with Aue based on improper hindsight. Accordingly, Applicants submit that the Office has not met its burden in establishing a *prima facie* case of obviousness with regards to claims 2 and 3. Applicants respectfully request withdrawal of the rejection.

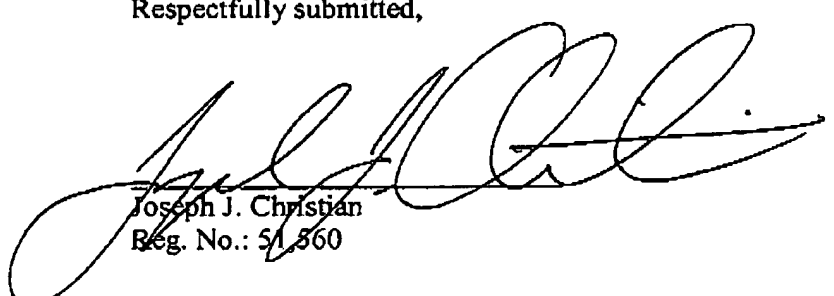
Further, with regard to claim 7, Applicant respectfully submits that there is no motivation to make the further combination of Bultan (i.e., integrate and dump stages) into the aforementioned Rademacher, El-Tarhuni, Choi, Aue combination. Similar to the above discussions regarding Choi and Aue, it appears the Office has, once again, made the combination with Bultan based on improper hindsight. Clearly, it is improper to make a combination of such a multiplicity of references without showing any of the requisite teachings in the art as to why it would be obvious to make such a voluminous combination. Accordingly, Applicants submit that the Office has not met its burden in establishing a *prima facie* case of obviousness with regards to claim 7. Applicants respectfully request withdrawal of the rejection.

IV. CONCLUSION

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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